

#### IV. Remarks.

The Examiner entered the following rejections in the office action.

1. Claim 9 is rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 is amended.

2. Claims 1-6 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 10 and 11 of U. S. Patent No. 6,461,268.

*Reference and Application not Commonly Owned.*

The reference upon which the Examiner has based this rejection, US 6461268, and the application are not commonly owned and therefore a terminal disclaimer is not applicable. The inventors in this case (Ser. No. 10/780,979) are Imtiaz Ali and Alexander Serkh, each of whom is employed by the assignee Gates Corporation. The inventor in the case of the reference (US 6461268) is Peter James Milner and the assignee is Orbital Traction Ltd.

The Gates Corporation is not commonly owned with Orbital Traction Ltd. Neither The Gates Corporation nor Orbital Traction Ltd is a subsidiary of the other.

Mr. Milner did not participate in the patentable improvements which are claimed in this application and hence he is not listed as an inventor.

Applicant respectfully asserts that this is not a case of double-patenting and a terminal disclaimer is not applicable in this situation.

#### *103 Rejection*

Based upon the foregoing assertions, the Applicant responds to the obviousness rejection based upon the assumption that the Examiner will withdraw the double-patenting rejection.

A rejection based on 35 U.S.C. §103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. In Re Raynes, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed.Cir.1993). In the context of an analysis under §103, it is not sufficient merely to identify one reference that teaches several of the limitations of a claim and another that teaches several limitations of a claim to support a rejection based on obviousness. This is because obviousness is not established by combining the basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501-02, 226 U.S.P.Q.

(BNA) 1005, 1009-10 (Fed. Cir. 1985). Obviousness can not be established by hindsight combination to produce the claimed invention. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed.Cir.1991). The relevant analysis invokes a cornerstone principle of patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is . . . simply irrelevant. Virtually all inventions are combinations and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).

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A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. American Hoist & Derek Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

There must be a rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. In re Dembiczak, 175 F.3d 994, 999 (Fed.Cir.1999). This is because "combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability." Id. Accordingly, to establish a rejection under 35 U.S.C. §103, a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, but also some motivation to combine the prior art teachings in the particular manner claimed. In re Kotzab, 217 F.3d 1365, 1371 (Fed. Cir. 2000). In other words, the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

In this case the Examiner only offers a single reference.<sup>1</sup> Milner (US '268) teaches a continuously variable transmission device of the type having planetary members in rolling contact with radially inner and outer races each comprising two axially spaced parts, with control means for selectively varying the axial separation of the two parts of one race and thus the radial position of the planetary members in rolling contact therewith, in which there are provided means sensitive to the torque applied to a drive-transmitting member of the transmission operable both to determine the compensating variation in the separation of the two parts of the other race and thus the transmission

<sup>1</sup> A rejection under 35 USC § 102 differs from that for obviousness, 35 U.S.C. § 103, in that prior knowledge by others requires that all of the elements and limitations of the claimed subject matter must be expressly or inherently described in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed.Cir.1999)

ratio of the device and to vary the forces exchanged between the planets and the races normal to the interface between them.

The Examiner incorrectly bases the rejection in part on the assumption that "[the claims] are not patentably distinct from each other because claim 1 of the present application encompasses limitations that are already patented in claim 1 of the U.S. patent." The single cited reference, US '268, does not teach several of the claim limitations, namely:

"a drive motor engaged with a self locking drive comprising a worm gear engaged with the adjustment member and a frictional member engaged with the worm gear;

the self locking drive preventing turning movement of the adjustment member when the drive motor is not energized;

a first endless member connecting a driver and the input drive member;

a first accessory directly connected to a first end of the output drive member; and

a second accessory driven by a second endless member engaged with the output drive member."

In support of this rejection the Examiner does not offer another reference or references in combination to teach the noted limitations. Hence, there is insufficient teaching or motivation to make the claimed combination in the absence of additional references. The Examiner does not argue that any of the noted limitations are inherent.

More particularly, there is no teaching in US '268 to combine a motor and endless member to a self locking drive, nor is any reference offered containing these limitations. The self locking drive prevents turning movement of the adjustment member when the drive motor is not energized. Lastly, there is no teaching in US '268 to combine a first and second accessory to the output drive member of the transmission.

Instead, the only means taught by US '268 for controlling the position of outer raceways (26) is a simple adjusting mechanism (29), col. 8, lines 51-59. Adjusting mechanism (29) comprises a very simple apparatus consisting of a lever (30) pivotally mounted on a reaction member (31). The lever and pivot is the most basic of mechanisms and offers no teaching toward the mechanism claimed in the instant application.

Applicant requests the rejection be withdrawn.

**V. Fees.**

Fees payable for this argument and request for extension of time may be deducted from deposit account 07-0475 in the name of The Gates Corporation.

Thank you for your attention to this case. If any questions arise, please call at the number below.

Sincerely,



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Date: Nov. 28, 2005